UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,063	09/11/2003	Margaret A. R. Beynon	GB920020082US1	6190

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EXAMINER
NUNEZ, JORDANY

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2007*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-15 and 17-31* is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1, 3-15, 17-31* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some *   c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

12/21/2007 has been entered.

Claim Objections

The specification is objected to as failing to provide proper antecedent basis for the

claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of

the following is required: "a tangible medium" lacks antecedent basis in the

specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claim 29 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claim 29 is drawn to a "computer set of

instructions embodied in a tangible medium". One of ordinary skill in the art would read

the limitations of the claim as software, per se, as no explicit or inherent statutory

substrate to embody the instructions can be read into the claim.

Claims 1, 3-14, 30 and 31 are rejected under 35 U.S.C. 101 because the claimed

inventions are directed to non-statutory subject matter. Claims 1, 30 and 31 are drawn

to an "apparatus," "client" and "server," respectively, comprising "means." One of

ordinary skill in the art would read the "means" of the claim as software, per se,

because, for example, the "means" may be reasonably be interpreted as a software

"object" (specification, page 20, lines 16-17, "category object which analyse the

message [...]"; specification, page 21, lines 12-14, the "the coordinator object analyses

[...]"). One of ordinary skill in the art would understand that the recited objects are

software, per se. Any claim not individually addressed is rejected based upon the

rejection of the claims from which it depends.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 1, 3-9, 13, 15, 17-23, 27, 29-31 are rejected under 35 U.S.C. 102(e) as

being anticipated by Okada et al. (US7099867, hereinafter Okada) in view of Mandato

et al (US20010025280, hereinafter Mandato), in view of Hayes-Roth (US20020054072).

As to claims 1, 15, 29-31:

Okada shows an apparatus, method, computer program, client and server for

adding context to a chat transcript, comprising:

means for receiving a first message, defining at least a part of said chat

transcript, from a user (column 4, lines 60-67);

 means for analysing text of said first message (column 5, lines 1-6);

means for assigning (Examiner reads as –identifying--) a verb (e.g., patent,

meeting) to the text of said first message (column 12, lines 27-34);

and means for associating the verb with the user from which the first message is

received (column 4, lines 53-59);

means, responsive to analysis of the text, for modifying said text to create a

second message in order to add context thereto (column 7, lines 32-41);

and means for transmitting said second message to interested parties (figure 7,

top),

Okada fails to specifically show: wherein the second message is different than

the first message as defined by an alteration to the first message selected from the

group consisting of an addition of text to the first message, a deletion of text from the

first message, and a replacement of text in the first message, and modifying said text of

said first message by adding an assigned verb and a user associated with said

assigned verb to said text of said first message.

In the same field of invention, Mandato teaches: a method of identifying a

characteristic of a subscriber's device. Mandato further teaches: wherein the second

message is different than the first message as defined by an alteration to the first

message selected from the group consisting of an addition of text to the first message, a

deletion of text from the first message, and a replacement of text in the first message

(page 2, paragraph [0042]; page 3, paragraphs [0044] and [0046]).

In the same field of invention, Hayes-Roth teaches: a interactive messenger

sending an agent to a recipient. Hayes-Roth also teaches: a customizable messenger

role created for a messenger, the role containing a sequence of interactive steps that

the messenger will work through while interacting with a messenger recipient, the steps

containing variables, such as sender-name, recipient-name, sender-message, and

sender-question, these variables being replaced by customized values specified by a

sender, for use in interaction with a designated recipient, for example, the variables

might be replaced with alternative values, such as: sender-name= "Mom," recipient-

name="Aaron," sender-question= "Did you get something for your girlfriend?",

messenger-mood=happy (page 3, paragraph [0025], lines 1-10)

Thus, it would have been obvious to one of ordinary skill in the art, having the

teachings of Okada, Mandato, and Hayes-Roth at the time that the invention was made,

to have combined the second message being different than the first message as

defined by an alteration to the first message selected from the group consisting of an

addition of text to the first message, a deletion of text from the first message, and a

replacement of text in the first message of Mandato and the customizable messenger

role created for a messenger, the role containing a sequence of interactive steps that

the messenger will work through while interacting with a messenger recipient, the steps

containing variables, the variables being replaced by customized values specified by a

sender for use in interaction with a designated recipient of Hayes-Roth with the

apparatus, method, computer program, client and server as taught by Okada.

One would have been motivated to make such combination because a way to improve user

mobility and context awareness would have been obtained and desired, as expressly taught by Mandato

(page 1, paragraph [0005], lines 10-14).

As to claims 3, 17, Hayes-Roth shows:

wherein the means for assigning a verb (e.g., "says") to the text of said first

message (e.g., "sender-message" (figure 2, line 3) , comprises:

means for looking for matches (e.g., filling in standard electronic form with pre-

define slots) (page 3, paragraph [0028], lines 1-5) between at least a portion of the text

and at least one list, each item in a list being associated with at least one verb (e.g.,

asking, telling, answering) (page 3, paragraph [0026], lines 5-15); and

means for selecting (e.g., instructing messenger to deliver a message) a verb

associated with a matched item (page 3, paragraph [0025], last 5 lines).

As to claims 4, 18, Hayes-Roth shows:

wherein a plurality of verbs (e.g., says, says to tell you) are associated with at

least one item in at least one list (fig. 5, lines 4-13).

As to claims 5, 19, Okada shows:

wherein associated verbs are assigned weightings which determine how often

said verbs are assigned by said assigning means (column 12, lines 51-60)

As to claims 6, 20, Hayes-Roth:

wherein the means for assigning a verb to the text of said first message

comprises: means for replacing at least a portion of the text of said first message with

said verb (fig. 5, lines 4-13).

As to claims 7, 21, Okada shows:

wherein said means for modifying the text in order to add context thereto

comprises: means for defining how the text should be displayed at a client according to

at least one predefined rule (column 7, lines 32-41).

As to claim 8, 22, Okada shows:

comprising: means for instructing said client how to display said text, based upon

at least one predefined rule (column 7, lines 32-41).

As to 9, 23, Hayes-Roth shows:

means for a user to indicate their mood (e.g., mood=happy) (figure 4, line 8-12);

and

means for using said indicated mood to influence (e.g., talk-neutral, talk-happy)

the context added to said text of said first message (figure 5. lines 2-16).

As to claims 13, 27, Okada shows:

comprising: means for informing a user to whom the text belongs of the

suggested context (column 7, lines 18-25);

means for receiving acceptance or rejection of said suggested context (column 7,

lines 11-15);

and means for acting upon said rejection or acceptance (column 7, lines 15-25).

Claims 10, 14, 24, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Okada in view of Mandato in view of Hayes-Roth, further in view of Kurlander

(US6069622)

As to claim 10, 14, 24, 28:

Okada, Mandato, and Hayes-Roth show an apparatus and method substantially

as claimed, as specified above.

Okada further shows: an IRC window is displayed may be modified to indicate

the occurrence of the keyword (e.g., assigning context based on a predetermined

theme) (column 7, lines 26-28).

Hayes-Roth further shows means for a user to indicate their mood (e.g.,

mood=happy) (figure 4, line 8-12); using said indicated mood to influence (e.g., talk-

neutral, talk-happy) the context added to said text (figure 5. lines 2-16); including an

adverb (e.g., right away, great, by the way) as part of said context, said adverb chosen

according to the mood indicated by the user (figure 5, lines 14-20)

Okada, Mandato, and Hayes-Roth fail to specifically show means for including an

adverb as part of said context, said adverb chosen according to the mood indicated by

the user, and comprising means for assigning context based on a predetermined theme.

In the same field of invention, Kurlander teaches: comic panel generation based

on input of text. Kurlander further teaches: comprising means for a user to indicate their

mood (column 9, lines 47-52), means for using said indicated mood to influence the

context added to said text (column 9, lines 54-56), means for including an adverb as

part of said context, said adverb chosen according to the mood indicated by the user (column 10, lines 26-32), and a male character stating that he is from Ohio, the word "Ohio" being a predefined trigger word, and a system modifying the background to show a map of Ohio (e.g., assigning context based on a predetermined theme) (column 8, lines 47-51).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato, Hayes-Roth and Kurlander at the time that the invention was made, to have combined the comprising means for a user to indicate their mood, means for using said indicated mood to influence the context added to said text, and means for including an adverb as part of said context, said adverb chosen according to the mood indicated by the user of Kurlander with the apparatus and method as taught by Okada, Mandato, and Hayes-Roth.

One would have been motivated to make such combination because a way to aid a user gain a complete picture of a chat session would have been obtained and desired, as expressly taught by Kurlander (column 2, lines 14-16).

Claims 11, 12, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada in view of Mandato in view of Hayes-Roth, further in view of Miyashita (US20030154250).

As to claims 11, 12, 25, 26:

Okada, Mandato and Hayes-Roth show an apparatus and method substantially as claimed, as specified above.

Okada and Mandato and Hayes-Roth fail to specifically show: comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat.

In the same field of invention, Miyashita teaches: a client computer displaying chat log data. Miyashita further teaches: comprising means for storing a history of the chat transcript (page 4, paragraph [0060]) and comprising means for updating said stored chat transcript (page 4, paragraph [0070]); means for reflecting any changes in said transcript on the display screens of users involved in the chat (page 4, paragraph [0072]).

Thus, it would have been obvious to one of ordinary skill in the art, having the teachings of Okada, Mandato, Hayes-Roth and Miyashita at the time that the invention was made, to have combined the comprising means for storing a history of the chat transcript and comprising means for updating said stored chat transcript; means for reflecting any changes in said transcript on the display screens of users involved in the chat of Miyashita with the apparatus and method as taught by Okada, Mandato, Hayes-Roth.

One would have been motivated to make such combination because a way to enable a plurality of users to communicate with one another more smoothly would have

been obtained and desired, as expressly taught by Miyashita (page 1, paragraph

[0006]).

References to specific columns, figures or lines should not be limiting in any way.

The entire reference provides disclosure related to the claimed invention.

Response to Arguments

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, Applicant's arguments with respect to above claims

have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

Rafal et al.   [US20020002586]

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JORDANY NUNEZ whose telephone number is

(571)272-2753. The examiner can normally be reached on Monday Through Thursday

9am-7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Weilun Lo can be reached on (571)272-4847. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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you have questions on access to the Private PAIR system, contact the Electronic

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JN
2/25/2008

/Weilun Lo/
Supervisory Patent Examiner, Art Unit 2179